

## REMARKS

Claims 1-4, 6-13, 15, and 16 are pending and stand rejected. Applicants respectfully request reconsideration of the present application in view of the amendments set forth above and the remarks below.

### Amendments to the Claims

Applicants amend independent claims 1 and 13 to delete the term “non-destructive,” and to clarify that the first and second members include *substantially circular* tissue-contacting conductive elements extending therealong. Support for this amendment can be found throughout the specification, for example in paragraphs 0038, 0043 and 0044 of the published application. No new matter is added.

### Rejections Pursuant to 35 U.S.C. §112

The Examiner rejects claims 1-4, 6-13, 15, and 16 pursuant to 35 U.S.C. §112, second paragraph for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In particular, the Examiner argues that it is unclear what is meant by “a non-destructive tissue-contacting conductive surface,” as the Examiner submits there is no reference in the specification to “a non-destructive tissue-contacting conductive surface.” Therefore, the Examiner asserts that the phrase is new matter.

Independent claims 1 and 13 have been amended to delete the term “non-destructive,” thereby obviating the basis for this rejection.

### Rejections Pursuant to 35 U.S.C. §103

#### Yamanashi and Dorn

The Examiner rejects claims 1-4, 7, 8, 10, 13, and 15 pursuant to 35 U.S.C. §103(a) as being obvious over U.S. Patent No. 5,964,759 of Yamanashi et al. in view of U.S. Patent No.

6,334,860 of Dorn. The Examiner also cites several additional references in rejecting the dependent claims. Applicants respectfully disagree with the rejections.

Neither Yamanashi nor Dorn teaches or even suggests first and second members having substantially circular tissue-contacting conductive elements or surfaces extending therealong, as required by independent claims 1 and 13. As shown in FIGS. 2-5, the only portion of the Yamanashi device that can be considered first and second members that are pivotally coupled to one another is the distal tip portion of each blade. The distal tips, however, do not include tissue-contacting conductive element extending therealong, much less conductive elements having a substantially circular shape. Rather, the distal tips *are* the tissue-contacting conductive elements, and each tip does not have a substantially circular shape. Dorn does not remedy the deficiencies of Yamanashi because Dorn likewise fails to teach or even suggest first and second members having substantially circular tissue-contacting conductive elements or surfaces extending therealong. As shown in Figure 2, each jaw has a substantially planar surface with “conductive elements 36, 38 having a *plate-like form . . .*” (Col. 5, line 41, emphasis added.) Accordingly, independent claims 1 and 13 distinguish over Yamanashi and Dorn, taken alone or combined, and therefore represent allowable subject matter. Claims 2-4, 6-12, and 15-16 are allowable at least because they depend from an allowable base claim.

#### Fozard and Mehl

The Examiner further rejects claims 1, 3, and 11 pursuant to 35 U.S.C. §103(a) as being obvious over U.S. Patent No. 2,888,927 of Fozard in view of U.S. Patent No. 5,846,252 of Mehl, Sr. Applicants respectfully disagree.

Fozard discloses a device for removing hair that includes a gripping member, in the form of tweezers, and a high frequency generator for delivering current to the tweezers to destroy the root of a hair grasped therebetween. Fozard does not teach or even suggest first and second members having substantially circular tissue-contacting conductive elements extending therealong. Rather, the arms, which are substantially planar, form the conductive elements and they do not have a substantially circular shaped member disposed therealong.

Mehl does not remedy the deficiencies of Fozard, as Mehl likewise fails to teach or even suggest first and second members having substantially circular tissue-contacting conductive elements disposed therealong. Mehl, like Fozard, discloses a hair removal device having two tweezer arms that are substantially planar. Each tweezer arms includes a metal electromagnetic energy conduction pad. As shown in FIG. 2, the pads (24, 26) are substantially planar.

Accordingly, independent claims 1 and 13 distinguish over Fozard and Mehl, taken alone or combined, and therefore represent allowable subject matter. Claims 3 and 11 are allowable at least because they depend from an allowable base claim.

**Conclusion**

In view of the amendments and remarks above, Applicants submit that claims 1-4, 6-13, and 15-16 are in condition for allowance and allowance thereof is respectfully requested. Applicants encourage the Examiner to telephone the undersigned in the event that such communication might expedite prosecution of this matter.

Respectfully submitted,

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